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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,685	02/12/2001	Philip Waisin Ching	CHINGPH.002A	6131

20995 7590 08/02/2004

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EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2179

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/781,685	Applicant(s) CHING, PHILIP WAISIN	
	Examiner Adam M Queler	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/17/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed 02/12/2001, IDS filed 05/17/2001, and drawings filed 5/21/2004.
2. Claims 1-25 are pending in the case. Claims 1, 3, 13, and 21-24 are independent claims.

Double Patenting

3. Applicant is advised that should claim 2 be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
6. The term "further distinguished" in claim 7 is a relative term which renders the claim indefinite. The term "further distinguished" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For examining purposes only the term will be considered as "distinguished."

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Snyder et al (US006038561A – filed 9/15/1997).

Regarding independent claim(s) 1, Snyder teaches a database which stores the content of documents which inherently include a first and second document (Fig. 1A, 36). Snyder teaches that the documents include one or more segments c4.30-38. Snyder teaches a request to search the documents for a key phrase c3.61-64. Snyder teaches displaying a side-by-side display which lists identified segments from first document in a first list and identified segments from second document in a second list (Fig. 10C).

Regarding dependent claim(s) 2 and 25, Snyder teaches displaying several additional detail, for example the patent number (Fig. 10C).

Regarding independent claim(s) 3, Snyder teaches a system as set forth in claim 1 above with the document and its respective segment being analogous to a dataset and its respective division.

Regarding dependent claim(s) 4, Snyder teaches the divisions being documents (Fig. 10D). Snyder also teaches categories of documents, such as patents and non-patent literature c4.42-48. In this case the divisions would be document categories.

Regarding dependent claim(s) 5, Snyder teaches the divisions being documents (Fig. 10D).

Regarding dependent claim(s) 6, Snyder teaches that divisions can be segments c4.30-36.

Regarding dependent claim(s) 7, Snyder teaches identified divisions are distinguished in a side-by-side display (Fig. 10C).

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Regarding independent claim(s) 13, Snyder teaches a database which stores the content of documents which inherently include a first and second document (Fig. 1A, 36). Snyder teaches that the documents include one or more segments c4.30-38. Snyder teaches a request to search the documents for a key phrase c3.61-64. Snyder teaches displaying a display which lists identified segments from first document in a first list and identified segments from second document in a second list (Fig. 10C).

Regarding dependent claim(s) 14, Snyder teaches displaying a side-by-side display.

Regarding dependent claim(s) 15, Snyder teaches displaying a side-by-side display which lists identified segments from first document in a first list and identified segments from second document in a second list (Fig. 10C).

Regarding dependent claim(s) 8 and 16, Snyder teaches the first document is a text document (Fig. 10C).

Regarding dependent claim(s) 9 and 17, Snyder teaches the first document is a text document (Fig. 10C).

Regarding dependent claim(s) 10 and 18, Snyder itself is a patent, which would be searched by the invention. It is at least 50 pages in length, and therefore it and any other document would total 50 pages in length.

Regarding dependent claim(s) 11 and 19, Snyder itself is a patent, which would be searched by the invention. It is at least 50 pages in length.

Regarding dependent claim(s) 12 and 20, Snyder teaches that the document can be different types of documents, such as patents and non-patent literature c4.42-48.

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Regarding independent claim(s) 21, Snyder teaches a system as recited in claim 1 and in addition teaches that the documents comprise a hierarchy of elements c4.30-36.

Regarding independent claim(s) 22, Snyder teaches a system as recited in claim 1 and in addition teaches that the documents comprise a hierarchy of elements, the identified ones of which are displayed in the display c4.30-36.

Regarding independent claim(s) 23, the method of executing the system of claim 22 is rejected under the same rationale.

Regarding independent claim(s) 24, the claim is rejected similarly as claim 1 above, as a first and second document comprise a plurality of documents.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-6,064,968 A to Schanz, Stephen J.

US-2002/0116399 A1 to Camps et al.

US-6,438,566 B1 to Okuno et al.

US-6,449,624 B1 to Hammack et al.

US-6,658,626 B1 to Aiken, Alexander

Douglas et al., "Tracking and Viewing Changes on the Web", USENIX Technical Conference, 1996, pp. 1-13.

Wang et al., "Structural Matching and Discovery in Document Databases", Proceedings of the 1997 ACM SIGMOD International conference on Management of Data, Arizona, US, 1997, pp. 560-563.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213.

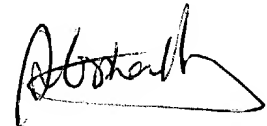
The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ



STEPHEN S. HONG
PRIMARY EXAMINER